

Remarks

Claims 1-9 are pending in the application. Reconsideration and allowance of the application are respectfully requested. In the discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

The non-final Office Action dated May 2, 2008 lists the following rejections: claims 1 and 5 stand rejected under 35 U.S.C. § 102(b) over Werner *et al.* (DE 100 07 415); claims 6 and 9 stand rejected under 35 U.S.C. § 103(a) over Werner; claim 7 stands rejected under 35 U.S.C. § 103(a) over Werner in view of Kim *et al.* (U.S. Patent No. 6,133,116), claims 2-4 stand rejected under 35 U.S.C. § 103(a) over Werner in view of Iijima *et al.* (JP 60-38877), and claim 8 stands rejected under 35 U.S.C. § 103(a) over Werner in view of Iijima or in view of Kim.

According to M.P.E.P. § 706.02, "If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." In this instance the copies of the Werner and Iijima references in the file wrapper are in a language other than English. These copies were provided by Applicant thereby satisfying the duty of disclosure with respect to the references. Now that the Office Action is relying upon the references as the basis for a rejection, a translation of the references is required. Without such a translation Applicant (and also any examiner who does not understand the non-English language) would be unable to determine the propriety of the rejection. Accordingly, the rejections for each of the claims are improper and Applicant requests that they be withdrawn. Should the rejections be maintained, an English translation must be obtained and Applicant would request an opportunity to respond before a final office action to develop a clear issue pursuant to M.P.E.P. § 706.07.

Notwithstanding, Applicant has amended claim 1 to facilitate prosecution while reserving the right to pursue other claim scopes in the future, such as through a continuation. Applicant respectfully traverses the § 102(b) rejection of claims 1 and 5 because, as indicated by the Office Action with regard to the cancelled claim 2, the cited portions of the Werner reference do not appear to correspond to the claimed invention

which includes, for example, aspects directed to a conductive shield plate extension. Accordingly, the § 102(b) rejection of claims 1 and 5 is improper and Applicant requests that it be withdrawn.

Applicant respectfully traverses the rejection of claims 3-4 under 35 U.S.C. § 103(a) over Werner in view of Iijima for failing to provide an English translation of the reference, failing to show correspondence to each limitation and for failing to show a legitimate reason to combine elements from the references.

Applicant notes that claim 1 now includes limitations directed to those limitations previously found in now cancelled claim 2. As such, Applicant respectfully submits that the rejection of claim 2 was improper and cannot be used to sustain a rejection of claim 1. The Office Action provides a conclusory statement that portion 8 of Iijima is a shield plate but provides no support for this conclusion. Moreover, the Office Action offers the conclusory statement that a lateral extension would provide a higher shielding effect. Applicant respectfully requests the Office Action provide support for these conclusory statements and for the statement that the skilled artisan would view the teachings of Iijima as suggesting a modification of the teachings of Werner. For example, Applicant notes that the relied upon portion 8 of Iijima does not appear to be an extension of any other shield portion. Thus, the only teachings that support the claimed extension are found in Applicant's specification. Pursuant to M.P.E.P. 2141 and the Supreme Court "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) cited with approval in *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007). Here the Office Action has concluded both that portion 8 of Iijima is taught to provide shielding and that the skilled artisan would have a reason to make portion 8 of Iijima an extension of the portion relied upon in Werner.

Applicant respectfully traverses the rejection of claim 3 for the reasons discussed in connection with claim 1, including failing to show correspondence to the claim limitations and further failing to provide an adequate reason to combine the elements. As discussed above, the Office Action has relied upon conclusory statements. Moreover, the Office Action has not shown how the references teach or suggest how to reduce the

number of steps during the manufacture of the shielded transistor, which is the alleged motivation to combine. Applicant respectfully requests clarification as to what manufacturing process the Office Action is improving over and also requests further details on what the “new” manufacturing process entails and where support for such a manufacturing process is to be found (*i.e.*, analysis and support for the conclusory statement of an advantage).

With regards to the rejection under 35 U.S.C. § 103(a) of claims 4, 6 and 8-9, the Office Action improperly applies the holding in *In re Aller*, 105 USPQ 233, 1955. *In re Aller* involved a case where the claims *only* differed from the prior art with regard to the temperature and concentration (*see, e.g.*, M.P.E.P. § 2144.05). Here, the disclosure of the Werner reference (FIG. 1) exhibits differences other than the ranges, including but not necessarily limited to, embodiments with an extension and/or with the shield being at a depth relative to the body portion. Thus, Applicant submits that the general conditions of the claims are not disclosed in the prior art and that the record does not support that routine experimentation of the device of the Werner reference would result in the claimed ranges. For example, there are no teachings in the record that show that the claimed ranges would be an optimization to the combination asserted by the Office Action. Instead, the Office Action erroneously concludes that because Applicant’s claimed invention teaches such ranges, the same ranges would be applicable to the Office Action’s combination. Accordingly, the Office Action’s use of the holding of *In re Aller* is improper, and Applicant requests that the rejections be withdrawn.

Moreover, the Office Action has not provided any reason why one of skill in the art would modify Werner’s device to have the dimensions as claimed in claims 4, 6 and 8-9 and merely concludes this to be the case. This approach is contrary to the requirements of § 103 and relevant law. *See, e.g., KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007) (“A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.”). In this instance, the Office Action fails to provide any evidence as to why one of skill in the art would modify the Werner reference. The Werner reference fails to identify any dimensions relative to the portions cited by the Office Action. As best understood by Applicant (without a translation), Werner appears to have no appreciation

for advantages resulting from the various claimed dimensions (*see, e.g.*, claim 9 and paragraph 0023 of Applicant's specification) or any purpose to conduct any such experimentation towards Applicant's dimensions. *See, e.g.*, M.P.E.P. § 2144.05. Thus, the skilled artisan would not be motivated to modify the Werner reference in any manner relative to the claimed invention or its attributes. In addition, Applicant submits that, in the absence of a valid reason why the skilled artisan would modify Werner, the Office Action appears to be improperly resorting to hindsight reconstruction based upon Applicant's disclosure in an attempt to arrive at a combination that corresponds to the claimed invention. *See, e.g.*, M.P.E.P. § 2142.

In view of the above, the Office Action has failed to establish a *prima facie* case of obviousness.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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